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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,803

06/27/2003

Thomas W. Ives

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6856

7590

08/26/2004

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,803

Applicant(s)

IVES ET AL.

Examiner

Ross N. Gushi

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/3/07
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 21, 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8, 10-16, 21, 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/27/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1, shown in figure 3; Species 2, shown in figures 4-8; Species 3, shown in figures 9-10; Species 4, shown in figures 11-18.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none are generic.

Applicant's election with traverse of the species of Species 4 shown in figures 11-18 in the reply filed on 6/10/04 is acknowledged. The traversal is on the ground(s) that a prima facie case has not been made and the claims do not meet the general test. The applicant's arguments are not persuasive. First, the species include inventions that would be classified separately. For example, species 2, as claimed in claim 1, would be classified in class 439/374 (because of the claimed guide for constraining movement). Species 4, would probably be classified in class 439, subclasses 342, 345, or 372, depending on particular limitations claimed. Thus the species have different classifications. Furthermore, the searches required for the species are different, species 4 would not require a search in class 439/374 and species 2 would not require searching in subclasses 342, 345, or 372. Similarly, the other species have other classifications and fields of searches.

Applicant also argues that the claims are not mutually exclusive. The examiner maintains that the species are mutually exclusive, as discussed below in the 35 USC 112 first paragraph rejection.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

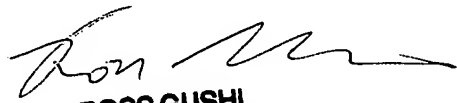
Claims 1-8, 10-16, and 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has elected species 4, shown in figures 11-18. Applicant concedes that the alignment members 171, 172, move the objects toward each other in the lateral direction indicated by arrow 185. Claim 1 recites a guide (reference number 134) that substantially constrains movement of the objects (110, 120) longitudinally along paths 131, 132. As noted in the Office action dated 6/29/04, the elected species 4 can not be operated with such guides. See figures 11-13. The elected species 4 is incompatible with claim 1 and incompatible with the guides disclosed in the specifications and drawings.

In response to the Office action dated 6/29/04, Applicant argues that the guides can act to align the objects as shown in figure 13. The examiner is not persuaded. First, nowhere in the specification or in any drawing is there any suggestion that the assembly as shown in figure 13 alone, disregarding figures 11, 12, and 14-16, might be used in combination in with the guides shown in figure 4. Nowhere in the originally filed specification and drawings is there any suggestion that the invention might be reconfigured as suggested in applicant's arguments. A person with ordinary skill in the art would have no basis whatsoever for taking the configuration of figure 13 completely out of context of the specification and drawings and somehow applying it to the configuration shown in figure 4, rendering the remaining figures 11, 12, and 14-16 completely inapplicable. Furthermore, cam surface 181 would serve no purpose if the invention was to be rearranged as suggested.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (571) 272-2005. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at 571-272-2800 extension 33. The phone number for the Group's facsimile is (703) 872-9306.


ROSS GUSHI
PRIMARY EXAMINER